

REMARKS

This application has been reviewed in light of the Office Action dated February 24, 2005. Claims 2, 4-6, 11, 17 and 20-25 are presented for examination. Claims 1, 3, 7-10, 12-16, 18 and 19 have been canceled, without prejudice or disclaimer of subject matter. Claims 2, 4-6, 11, 17, 20 and 21 have been amended to define still more clearly what Applicant regards as his invention. Claims 22-25 have been added to provide Applicant with a more complete scope of protection. Claims 2, 17, 20 and 21 are in independent form. Favorable reconsideration is requested. The canceled claims will not be further addressed herein.

The specification has been amended to conform the Summary of Invention section to the amended claims.

Applicant notes with appreciation the indication that claims 4-10 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 101, and if rewritten so as not to depend from a rejected claim. Claims 4-6 have not been so rewritten because, for the reasons given below, the respective base claim of each is believed to be allowable.

An Information Disclosure Statement with a corresponding Form PTO-1449 was filed on March 22, 2004, as evidenced by the returned receipt postcard bearing the stamp of the Patent and Trademark Office, a copy of which is attached hereto. Applicant respectfully requests the Examiner to return an initialed copy of the Form PTO-1449, indicating the reference cited thereon was considered.

Claims 2-11 and 16-21 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, and under 35 U.S.C. § 101, for the reasons set forth in paragraphs 1 and 2 of the Office Action. The claims have been carefully reviewed and amended as deemed necessary to

ensure that they conform fully to the requirements of Section 112, second paragraph, and Section 101, with special attention to the points raised in paragraphs 1 and 2 of the Office Action. It is believed that these rejections have been obviated, and their withdrawal is therefore respectfully requested.

Claims 2 and 11 were objected to under 37 C.F.R. § 1.75 as being substantial duplicates of Claims 12 and 15, respectively. Cancellation of Claims 12 and 15 renders this objection moot.

Claims 1-3, 12-14 and 16-21 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,278,529 (Akimoto), and Claims 11 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Akimoto.

As indicated above, Applicant has amended independent Claims 2, 17, 20 and 21 in terms that more clearly define what he regards as his invention. Applicant submits that these amended independent claims, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

Claim 2 is directed to a communication apparatus including an image processor, arranged to process color and monochrome images, and a communication controller, arranged to control a communication with a partner apparatus. The apparatus also includes a setter, arranged to set whether a color image is transmitted as a monochrome image or not when the partner apparatus does not have color reception performance, and a mode controller, arranged to control a switch between a memory transmission mode which starts transmission of an image after the image is stored in a memory, and a direct transmission mode which generates an image to be transmitted after the communication with the partner apparatus is started. When transmission of a color image is instructed, the mode controller selects the memory transmission mode if the

transmission of the color image as a monochrome image is inhibited by the setter, or the direct transmission mode if such transmission is permitted by the setter.

Among other notable features of Claim 2 are (1) a setter, arranged to set whether a color image is transmitted as a monochrome image or not when the partner apparatus does not have color reception performance, and (2) a mode controller, arranged to control a switch between a memory transmission mode which starts transmission of an image after the image is stored in a memory, and a direct transmission mode which generates an image to be transmitted after the communication with the partner apparatus is started, and (3) that when transmission of a color image is instructed, the mode controller selects the memory transmission mode if the transmission of the color image as a monochrome image is inhibited by the setter, or the direct transmission mode if such transmission is permitted by the setter.

By virtue of the structure of the apparatus of Claim 2, a user sets in advance, whether an image is transmitted as a monochrome image or not when a partner apparatus does not have color reception performance. Further, when transmission of a color image is instructed, and the transmission of a monochrome image is permitted, the communication apparatus starts reading the original after the determination of whether the partner apparatus has the color reception performance by selecting the direct transmission mode. As a result, the decoding of color image data read from an original and stored in the memory, conversion of the decoded color image data to monochrome image data, or encoding of the monochrome image data is not necessary, when the transmission of a color image as a monochrome image is permitted.

Akimoto relates to a communication apparatus for transmitting color image data and monochrome image data to a partner device. Akimoto discusses a color key, which when depressed by the user, is used to read the original as a color original, and a switch key used to

change between two transmission modes, i.e., a memory transmission mode and a direct transmission mode. In the direct transmission mode of Akimoto, after an original is placed on a support plate, the telephone number of a communication partner is input and dialed. A digital identification signal (DIS) is received from the partner device that includes information as to whether or not the partner device can perform color communication. If the color key was not depressed (i.e., the apparatus was not instructed to read the original as a color image), an encode mode when reading the original is set to monochrome to transmit the original as a monochrome original.

If the color key was depressed and the DIS received from the partner device indicates that the partner device has the color communication function, the encode mode when reading the original is set to JPEG to transmit the original as a color original. On the other hand, if the color key was depressed and the DIS received from the partner device indicates that the partner device does not have the color communication function, the encode mode when reading the original is set to monochrome to transmit the original as a monochrome original (alternatively, Akimoto discusses first obtaining confirmation from the user before setting the encode mode to monochrome).

In the memory transmission mode of Akimoto, if the color key was depressed, the original is read as the color original and JPEG encoded to store obtained data in an image memory. If the color key was not depressed, the original is read as a monochrome original and binary encoded to store obtained data in the image memory. If the color key was depressed and the DIS received from the partner device indicates that the partner device has the color communication function, the digital command signal (DCS) for color transmission is generated and transmitted. If the color key was depressed and the DIS received from the partner device

indicates that the partner device does not have the color communication function, the JPEG-encoded color image is converted into a monochrome image and transmitted (alternatively, Akimoto discusses first obtaining user confirmation before converting the JPEG-encoded color image into a monochrome image). If the color key was not depressed, then the monochrome image is transmitted.

Applicant submits that nothing in Akimoto would teach or suggest “a setter, arranged to set whether a color image is transmitted as a monochrome image or not when the partner apparatus does not have color reception performance,” as recited in Claim 2.

Further, nothing in Akimoto would teach or suggest “a mode controller, arranged to control a switch between a memory transmission mode which starts transmission of an image after the image is stored in a memory, and a direct transmission mode which generates an image to be transmitted after the communication with the partner apparatus is started, wherein when transmission of a color image is instructed, the mode controller selects the memory transmission mode if the transmission of the color image as a monochrome image is inhibited by the setter, or the direct transmission mode if that is permitted by the setter,” as recited in Claim 2.

Accordingly, Applicant submits that Claim 2 is allowable over Akimoto, and respectfully request withdrawal of the rejection under 35 U.S.C. § 102(e).

A review of the other art of record, including the art cited in the Information Disclosure Statement filed concurrently herewith, has failed to reveal anything which, in Applicant’s opinion, would remedy the deficiencies of Akimoto, as a reference against Claim 2.

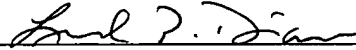
Independent Claims 17, 20 and 21 recite features similar to those discussed above with respect to Claim 2 and therefore are also believed to be patentable over the art of record for the reasons discussed above.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



Leonard P. Diana
Attorney for Applicant
Registration No.: 29,296

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 502262v1